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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/524,542	02/14/2005	Hsien-Kun Chu	LC-479/PCT/US	1405

7590

12/15/2006

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EXAMINER

ZIMMER, MARC S

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 12/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/524,542

Applicant(s)

CHU, HSIEN-KUN

Examiner

Marc S. Zimmer

Art Unit

1712

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 01 December 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): prior art rejections over Scheim et al.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: 10 and 15.
Claim(s) objected to: 5 and 6.
Claim(s) rejected: 1-4, 7-9, 12-14 and 16-20.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

Marc S. Zimmer

MARC S. ZIMMER
PRIMARY EXAMINER

Continuation of 11. does NOT place the application in condition for allowance because: Applicant continues to allege that Sakamoto fails to render obvious the claimed invention because it expressly provides for more components than are recited in the claims. It is Applicant's position that, because these additional components are present, there is no reasonable expectation that the improvement in skin over time is achieved. The Examiner vehemently disagrees. Applicant discloses a method involving a composition comprising an organosilicon compound having specific structural attributes and a hydroxysilyl-encapped organic- or siloxane polymer. The method entails combining these materials and then curing with the outcome being that skin-over time is vastly improved. Applicant does not explicitly delineate what aspect of their invention is responsible for the improved skin over times but there is some suggestion that the improvement comes from an acceleration of the rate-determining step which appears to be the reaction between components (I) and (II). Applicant devotes a fair amount of text to explaining that this reaction occurs more quickly when the silanes (I) are in use due to their ability to form a hypervalent transition state with the hydroxy-functional polymer thereby "easing the reaction". The invention disclosed by Sakamoto contains precisely these same materials and also a curing system and, hence, would benefit equally from the availability of this transition state. The only thing distinguishing the claims from the composition described by Sakamoto is the necessity for an alkoxy-alpha-silyl ester in the latter. However, Applicant has put forth no evidence that would suggest that the presence of this material slows the curing process. In fact, Applicant also contemplates the further addition of an alkoxysilane other than component (I) in paragraph 46. Insofar as Applicants, themselves, permit the incorporation of other condensation-reactive compounds, their position that a reasonable expectation of success is unlikely would seem to be completely without merit. Indeed, it seems the only thing that would lower expectations for success would be if there were a compound added that interfered with the realization of the aforementioned transition state between (I) and (II). There is no evidence that that alkoxy-alpha-silyl ester would interfere any more than, say, aminopropyltriethoxysilane. Accordingly, the Examiner is unconvinced by the Applicant's assertion that the claims should be patentable.